

PTO/SB/21 (09-04)

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission  
in triplicate

13

Application Number

09/877,317

Filing Date

June 8, 2001

First Named Inventor

Sie, John J. et al.

Art Unit

2143

Examiner Name

Boutah, Alina A.

Attorney Docket Number

19281-001610

**ENCLOSURES (Check all that apply)**

|   |   |  |
|---|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/ Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input checked="" type="checkbox"/> Appeal Communication to TC<br>(Appeal Brief (11 pages in triplicate))<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>Return Postcard |
|---|---|--|

Remarks The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|              |                                    |          |        |
|--------------|------------------------------------|----------|--------|
| Firm Name    | Townsend and Townsend and Crew LLP |          |        |
| Signature    |                                    |          |        |
| Printed name | William J. Daley                   |          |        |
| Date         | October 18, 2005                   | Reg. No. | 52,471 |

**CERTIFICATE OF TRANSMISSION/MAILING**

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I hereby certify that this correspondence is being deposited with the United States Postal Service with "Express Mail Post Office to Address" service under 37 CFR 1.10 on this date October 18, 2005 and is addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

|                       |                |      |                  |
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| Signature             |                |      |                  |
| Typed or printed name | Sara B. McPeak | Date | October 18, 2005 |



Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL

## For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 500)

**Complete if Known**

|                      |                     |
|----------------------|---------------------|
| Application Number   | 09/877,317          |
| Filing Date          | June 8, 2001        |
| First Named Inventor | Sie, John J. et al. |
| Examiner Name        | Boutah, Alina A.    |
| Art Unit             | 2143                |
| Attorney Docket No.  | 19281-001610        |

**METHOD OF PAYMENT (check all that apply)**

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 20-1430 Deposit Account Name: Townsend and Townsend and Crew LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

| Application Type | FILING FEES  |          | SEARCH FEES  |          | EXAMINATION FEES |          | Fees Paid (\$) |
|------------------|--------------|----------|--------------|----------|------------------|----------|----------------|
|                  | Small Entity | Fee (\$) | Small Entity | Fee (\$) | Small Entity     | Fee (\$) |                |
| Utility          | 300          | 150      | 500          | 250      | 200              | 100      |                |
| Design           | 200          | 100      | 100          | 50       | 130              | 65       |                |
| Plant            | 200          | 100      | 300          | 150      | 160              | 80       |                |
| Reissue          | 300          | 150      | 500          | 250      | 600              | 300      |                |
| Provisional      | 200          | 100      | 0            | 0        | 0                | 0        |                |

**2. EXCESS CLAIM FEES**

| Fee Description   | Small Entity |          |
|---|--------------|----------|
|   | Fee (\$)     | Fee (\$) |
| Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent            | 50           | 25       |
| Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent | 200          | 100      |
| Multiple dependent claims   | 360          | 180      |

**Total Claims**      **Extra Claims**      **Fee (\$)**      **Fee Paid (\$)**      **Multiple Dependent Claims**

\_\_\_\_\_ -20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_      **Fee (\$)**      **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20

**Indep. Claims**      **Extra Claims**      **Fee (\$)**      **Fee Paid (\$)**

\_\_\_\_\_ -3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

**Total Sheets**      **Extra Sheets**      **Number of each additional 50 or fraction thereof**      **Fee (\$)**      **Fee Paid (\$)**

\_\_\_\_\_ - 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

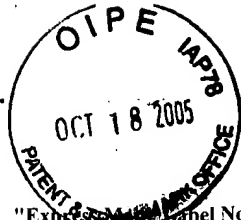
Other: Filing a brief in support of an appeal

Fees Paid (\$)

500

**SUBMITTED BY**

|                   |                  |  |                        |
|-------------------|------------------|--|------------------------|
| Signature         |                  | Registration No. (Attorney/Agent) 52,471 | Telephone 303-571-4000 |
| Name (Print/Type) | William J. Daley |  | Date October 18, 2005  |



10-20-05

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Date of Deposit: October 18, 2005

PATENT  
Attorney Docket No.: 19281-001610

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**MAIL STOP: APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By:

*Sara B. McPeak*

Sara B. McPeak

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

John J. Sie, et al.

Application No.: 09/877,317

Filed: June 8, 2001

For: PRE-STORING MULTIPLE PROGRAMS  
WITH USER CONTROL OF PLAYBACK

Customer No. 20350

Confirmation No.: 9420

Examiner: Boutah, Alina A.

Technology Center/Art Unit: 2143

**APPELLANT BRIEF UNDER**  
**37 CFR §41.37**

**MAIL STOP: APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellants offer this Brief further to the Notice of Appeal mailed on August 30, 2005. This Brief is submitted in triplicate.

10/21/2005 TBESHAH1 00000004 201430 09877317

01 FC:1402 500.00 DA

**1. Real Parties in Interest**

Privately held Starz Entertainment Group is the real party in interest of the above-identified application. Starz Entertainment Group is controlled by Liberty Media Corporation, a publicly-traded entity.

**2. Related Appeals and Interferences**

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

**3. Status of Claims**

Claims 1-21 are currently pending in the application. All pending claims stand rejected pursuant to a Final Office Action mailed June 8, 2005. The rejections of claims 1-21 are believed to be improper and are the subject of this appeal. A copy of the claims as rejected is attached as Appendix A.

**4. Status of Amendments**

The claims have been amended once in this case. More specifically, claim 19 was amended to correct an informality. The amendment was filed on March 7, 2005, in response to the Office Action mailed December 6, 2004. All other claims are original. This Appeal Brief is filed in response to the Office Action mailed on June 8, 2005.

**5. Summary of Claimed Subject Matter**

The invention generally relates to delivering and receiving a program using a near video on demand (NVOD) system including pre-storing a portion of a program at a user's location before the user selects the program. Application, page 4, lines 23-30. The embodiment of claim 1, relates to a method for receiving a program by a user location that is sent from a content provider. Id. at page 5, line 8 to page 8, line 16 and FIGs. 1-4. The method of this

embodiment includes recording at least a first segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs. Id. at page 19, line 17 to page 20, line 24 and page 33, lines 8-12. A user request for one of the first plurality of programs can be detected Id. at page 17, lines 8-20 and page 33, lines 13-22. If the user request is not detected before a stagger period expires, a second segment of each of a second plurality of programs sent from the content provider can be recorded. Id. at page 19, line 17 to page 20, line 24, and page 30, line 5 to page 34, line 15 and FIG. 21. If the user request is detected before the stagger period expires, the one of the first plurality of programs can be recorded. Id. at page 19, line 17 to page 20, line 24, and page 30, line 5 to page 34, line 15 and page 33, lines 23-28.

The embodiment of claim 9 relates to a method for receiving a program by a user location that is sent from a remote provider. Id. at page 5, line 8 to page 8, line 16 and FIGs. 1-4. The method includes determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored. Id. at page 19, lines 32-33 and page 22, lines 14-16. Any first segment of each of the plurality of programs that are not already stored can be recorded. Id. at page 22, lines 14-16 and page 19, line 17 to page 20, line 24 and page 33, lines 8-12. The user request for one of the plurality of programs can be detected. Id. at page 17, lines 8-20 and page 33, lines 13-22. A second segment of the one of the plurality of programs can be recorded in response to the detecting step Id. at page 19, line 17 to page 20, line 24, and page 30, line 5 to page 34, line 15 and page 33, line 23-28.

The embodiment of claim 16 relates to a method for receiving a program by a user location that is sent from a remote provider. Id. at page 5, line 8 to page 8, line 16 and FIGs. 1-4. The method includes recording at least a segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs. Id. at page 19, line 17 to page 20, line 24 and page 33, lines 8-12. A user request for one of the first plurality of programs can be detected. Id. at page 17, lines 8-20 and page 33,

lines 13-22. The one of the first plurality of programs can be recorded beyond a stagger period based upon the detecting step. Id. at page 19, line 17 to page 20, line 24, and page 30, line 5 to page 34, line 15 and page 33, line 23-28.

The embodiment of claim 19 relates to a method for receiving a program by a user location that is sent from a content provider. Id. at page 5, line 8 to page 8, line 16 and FIGs. 1-4. The method includes recording a first segment of the program sent from the content provider before any user request for the program. Id. at page 19, line 17 to page 20, line 24 and page 33, p lines 8-12. A user request for the program can be detected. Id. at page 17, lines 8-20 and page 33, lines 13-22. A second segment of the program can be recorded if the user request is detected before a period expires. Id. at page 19, line 17 to page 20, line 24, and page 30, line 5 to page 34, line 15 and page 33, lines 23-28. The recording of the first segment can be discontinued if the user request is not detected before the period expires, wherein the period is less than a duration of the program. Id. at page 30, line 5 - page 34, line 15

#### **6. Grounds of Rejection Presented for Review**

Claim 19 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. More specifically, the Office Action cites the claim element reciting "discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program" as not being described.

Claims 1-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by cited portions of U.S. Patent No. 6,701,528 of Arsenault et al. (hereinafter "Arsenault").

**7. Argument**

*A. Whether an enabling disclosure is provide din the detailed description to support claim 19.*

The final Office Action rejected claim 19 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. More specifically, the Office Action cites as not being described the claim element reciting "discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program." The Applicants respectfully argue that the detailed description of the pending application does in fact provide an enabling disclosure of the claimed subject matter.

Among possible other locations, this element is described in the detailed description of the Application on page 19, line 17 - page 20, line 24 describing saving an initial segment equal to the stagger time between program start times (i.e., less than the duration of the program) prior to a user selection, page 17, lines 8-20 describing ways in which a user may request or select content, and page 30, line 5 - page 34, line 15 describing discontinuing the recording of a first segment (i.e., the unselected channels) when the channel is not selected by the end of the first segment. More specifically the selected channel and only the selected channel is recorded beyond the first segment. Therefore, recording of the channels that are not selected is discontinued.

*B. Whether the priority date of the present application renders Arsenault ineffective as prior art against the pending claims.*

The final Office Action rejected claims 1-21 under 35 U.S.C. §102(e) as being anticipated by Arsenault. As argued previously, Applicants believe Arsenault is not prior art as it was filed January 26, 2000. Provisional Patent No. 60/163,324 (the "Parent Application"), filed on November 3, 1999, is in the priority claim for the present application.

Among possible other locations, the claims are supported in the Parent Application on page 11, line 23 through page 13, line 19; and in Figures 9 and 10. In fact, this section very closely matches portions of the Application cited above in support of the claimed subject matter. For example, the description in the Parent Application beginning on page 11 at line 23 discloses recording initial segments of a program available on different channels. Parent Application, page 12, lines 3-11 and lines 18-26. The segments size is about equal to the stagger time between program start times on the different channels. Id. at page 12, lines 3-26. These segments are recorded before input from the user. Id. at page 12, lines 18-26 and Fig. 10. Once user input selecting one of the channels is detected, the selected program is recorded beyond the first segment. Id. at page 12, lines 18-26 and Fig. 10. Therefore, Applicants maintain that the subject matter of the claims is in fact disclosed in the Parent Application that predates Arsenault. As such, Arsenault cannot be prior art against the pending claims.

#### **8. Conclusion**

Please deduct the requisite fee, pursuant to 37 C.F.R. §1.17(c), of \$500.00 from deposit account 20-1430 and any additional fees associated that may be due in association with the filing of this Brief.

If for any reason the Office believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Office is invited to telephone the undersigned attorney at (303) 571-4000.

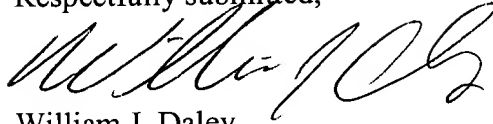
If for any reason the Office believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Office is invited to telephone the undersigned attorney at (303) 571-4000.



Appl. No. 09/877,317  
Appeal Brief dated October 18, 2005

PATENT

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William J. Daley', written in a cursive style.

William J. Daley  
Reg. No. 52,471

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**APPENDIX**

*The claims pending in the application are as follows:*

1. (Original) A method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:
  - recording at least a first segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs;
  - detecting the user request for one of the first plurality of programs;
  - recording at least a second segment of each of a second plurality of programs sent from the content provider if the user request is not detected before a stagger period expires; and
  - recording the one of the first plurality of programs if the user request is detected before the stagger period expires.
2. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the stagger period is a time duration between beginning the first plurality of programs and the second plurality of programs.
3. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the content provider is a cable television provider.
4. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the first plurality of programs are multiplexed together in a single datastream.
5. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein:
  - the first plurality of programs is transported with a first transponder, and
  - the second plurality of programs is transported with a second transponder.

6. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 1, further comprising a step of playing the one of the first plurality of programs.

7. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the detecting step comprises steps of:

receiving a wireless request from a remote control; and  
processing the wireless request to determine a desired program.

8. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location.

9. (Original) A method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored;

recording any first segment of each of the plurality of programs that are not already stored;

detecting the user request for one of the plurality of programs; and

recording a second segment of the one of the plurality of programs in response to the detecting step.

10. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs.

11. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different digital channels.

12. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders.

13. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs.

14. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of:

receiving a wireless request from a remote control; and  
processing the wireless request to determine a desired program.

15. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location.

16. (Original) A method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

recording at least a segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs;  
detecting the user request for one of the first plurality of programs; and

continuing to record the one of the first plurality of programs beyond a stagger period based upon the detecting step.

17. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 16, wherein the stagger period is the time between beginning the first plurality of programs and a second plurality of programs.

18. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 16, wherein the recording step comprises a step of recording the segment on a mass storage device associated with a set top box that is proximate to the user location.

19. (Previously Presented) A method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of the program sent from the content provider before any user request for the program;

detecting the user request for the program;

recording a second segment of the program if the user request is detected before a period expires; and

discontinuing the recording of the first segment if the user request is not detected before the period expires, wherein the period is less than a duration of the program.

20. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment.

21. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location.